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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/876,577

Applicant(s)

ANDERSON, GLEN J.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 and 4-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### **1.1. Claimed Invention(s) does not fall within the Technological Art.**

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable

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subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, **State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).**

In the present application, claims 1-2 and 4-8 do not recite use of technological arts in processing data. The steps recited in the claims 1-2 and 4-8 for providing a list of configuration choices, updated configuration choices, providing description of functions, receiving a selection of system configuration, presenting configuration choices in form of graphical icons, and developing personal history file for the user could be performed

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manually by people . Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection, the examiner recommends to amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating/integrating a computer/software/hardware computer network or electronic network functionally with manipulative steps recited in the claims.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.1. Claims 8, 16 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation " and comparison information regarding said selection and a product currently being utilized by a user " in lines 3-4, page 12. There is insufficient antecedent basis for this limitation in the claim. Claim 8 is a dependency of claim 1 and claim 1 does not recite any limitation related to receiving information/ knowledge about the current product being utilized by the user. If no information has been received about the current product being used by the user then it is unclear how a comparison information can be made and included in the description provided by the system. Claims 16 and 24 are rejected for the same reasons.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.1. Claims 1-4, 9-13 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson (US Patent 6,167,383) included in the IDS received on June 7, 2001.

Regarding claim 1, Henson teaches a method for configuring a build-to-order system (See at least abstract), comprising:

(a) providing a list of configuration choices, said list comprising available system elements with which said build-to-order system are configured;

(b) receiving a system configuration selection based on a combination of system elements selected from said list of configuration choices; and

(c) providing a description of a function capable of being implemented with said system configuration selection.

(For all the above three limitations see at least col.6, lines 18-43, " Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any

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*changes made to the system options. Selection of the update price function can be accomplished by clicking on an "UPDATE PRICE" icon 72 on the configuration screen. Upon obtaining a desired configuration, a customer could then select the "ADD TO CART" icon 74 to add the configured system to the shopping cart 20 and continue shopping, as desired. ....*

" . Note: In Figs. 3 A, 3 B and 3C Henson discloses providing a list of configuration choices in the form of displaying various choices for selecting memory, hard drive, monitor, etc., thereby prompting an user to make selections to configure and order a build-to-order computerized system. While presenting the choices, Henson also provides description of functions, see Fig. 3A: such as, a larger hard drive provides more storage space for the operating system..., monitors can deliver enhanced resolution and refresh rates, crisp, vibrant imaging and amazing color depth, etc.. Also see FIG.5 and col.9, lines 9-25)

Regarding claim 2, Henson teaches that the method as claimed in claim 1, further comprising the steps of: (a) receiving an updated system configuration selection; and (b) providing an updated description of a function capable of being implemented with said updated system configuration selection (see at least FIG.3C which discloses that by clicking the icon " UPDATE PRICE" on the bottom of Fig.3B the user receives an updated configuration selection with the updated price and functions also because any changes in the options would inherently show descriptions corresponding to the changed options .

Regarding claims 3 and 4, Henson teaches that the method as claimed in claim 1, wherein said list of configuration choices is presented in a graphical user interface and wherein at least one of said available system elements in said list of configuration



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choices being represented by an icon (see FIG.5 and col.9, lines 9-25 which shows that the options are represented by icons and menus on the screen and that is indicative of the use of a graphical user interface. Figs. 3A, 3B and 3C show the use of menus and dialog boxes and they are also indicative of the use of a graphical user interface).

Regarding claims 9-13 and 17-21 their limitations are parallel to the limitations of claims 1-4 and are therefore analyzed and rejected on the same basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 5-7, 13-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Tuzhilin (US Patent 6,236,978).

Regarding claims 5 & 6, Henson teaches a method for configuring a build to order system as analyzed and discussed in claim 1 above. Henson teaches identifying customers if they belong to a particular customer set (see col.13, lines 30-52) and then presenting the options accordingly. Henson does not disclose the step of developing a personal user history file for each user and including customized information pertaining to each user. However, in the same endeavor of e-commerce, Tuzhilin discloses the step of developing a personal user history file for each user (see at least

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FIGS 1, 2, col.2, lines 24-40, “ *The system and method according to the present invention generates dynamic profiles and, thereafter, transforms the dynamic profiles for various users into aggregate rules. ....* ”). In View of Tuzhilin, it would have been obvious to a skilled artisan in the art to have modified Henson to incorporate the feature of developing a personal user history file for each user and use this personal history file to provide customized information pertaining to each user because to provide better recommendations to the users as to which product and services each individual user should utilize, as explicitly disclosed in Tuzhilin ( see at least col.2, lines 41-59).

Regarding claim 7, Henson in view of Tuzhilin, as applied to claim 5, teaches a method for configuring a build to order system based upon a personal history file of the user as analyzed above. Henson in view of Tuzhilin, as applied to claim 5, does not disclose that said personal history file includes at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information. However, in the same endeavor of e-commerce, Tuzhilin discloses that said personal history file includes at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information (see at least FIGS 1, 2, col.2, lines 24-59, “ *The system and method according to the present invention generates dynamic profiles and, thereafter, transforms the dynamic profiles for various users into aggregate rules. ....* ”, and col.1, lines 27-col.2, line 10, “ *There are two basic types of user profiles that can be generated--a "static" profile and a "dynamic" profile. The static profile contains all of the factual information of the user including, for example, demographic data (e.g., age, sex, address), psychographic data (e.g., personality traits and habits), purchasing preferences (e.g., what does the user purchase in an average week), etc. Static profiles are generated using conventional methods that are known to those of ordinary skill in the art. ....Dynamic profiling information*

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*includes specific rules describing the user's behavior. .... In order to obtain an extensive understanding of the user, it is desirable to build both static and dynamic profiles for that user.*

..... "). In View of Tuzhilin, it would have been obvious to a skilled artisan in the art to have modified Henson to incorporate the feature of developing a personal user history file for each user by including at least one of a list of prior purchases, a list of browsed products, a current component configuration, and user-provided personal characteristic information because to provide better recommendations to the users as to which product and services each individual user should utilize, as explicitly disclosed in Tuzhilin ( see at least col.2, lines 41-59).

Regarding claims 13-15 and 21-23 their limitations are parallel to the limitations of claims 5-7 and are therefore analyzed and rejected on the same basis.

4.2. Claims 8, 16 and 24 are rejected under 35 U.S.C. 103(a) as being obvious over Henson in view of Official Notice

Regarding claim 8, Henson teaches a method for configuring a build to order system as analyzed and discussed above. Henson further discloses said description of function capable of being implemented with said system configuration selection includes at least one of advantages of said selection (see FIG.3B, " Scanners...." Wherein Henson describes the advantage of selecting a scanner), suggestions for other selections (see FIG.3B besides suggesting the selection of scanner it also suggests other selections such as, Software and accessories, power protection, etc.) , Henson does not disclose comparison information regarding said selection and a product currently being utilized by a user. The examiner takes Official Notice of both the

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fact and benefits of disclosing comparison information regarding a selection of a product to purchase and a product currently being utilized by a user. It is notoriously well-known that when a potential buyer visits a store to buy a computer system, TV, camera the salesman may enquire what model the buyer possesses or even sometimes the buyer informs the sales person about the product being currently used and now he wants to replace that product because it has become old/obsolete when compared to the new products. It is customary that either the customer himself may enquire the new features of the product that he wants to buy in comparison to the product that he is using or the sales man informs the buyer the comparison between his new selection and the current product being used by him because that will (a) motivate the buyer to buy the new selection and (b) would satisfy the buyer to spend the money to replace the currently old model.

Regarding claims 16 and 24 their limitations are parallel to the limitations of claim 8 and are therefore analyzed and rejected on the same basis.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,105,063 to Hayes Jr. (see at least col.4, lines 10-27) teaches a method and a system to " provide a common repository for configuration information for users and applets in a client-server environment (This is referred to as client profile management). The system allows users to roam, that is, to log-in from any computer in

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the system at any time and have it configured automatically at run time according to the preferences stored for the user at the server. ....”.

(ii) US Patent 5,993,841 to Schumacher et al. (see at least abstract) teaches:

“A structured document browser includes a constant user interface for displaying and viewing sections of a document that is organized according to a pre-defined structure. The structured document browser displays documents that have been marked with embedded codes that specify the structure of the document. The tags are mapped to correspond to a set of icons. When the icon is selected while browsing a document, the browser will display the section of the structure corresponding to the icon selected, while preserving the constant user interface.”.

(iii) US Patent 6,725,257 to Cansler et al. (see at least abstract) discloses providing a “ process for configuring a product using a server and a client connected by a computer network, wherein the product has multiple possible configurations, and wherein each configuration is defined by a set of standard attributes and a set of optional attributes.....”.

(iv) Press release; “ Dell Begins Shipping SellNet by MSN”; PR Newswire; New York; Nov 29; 2000; pg.1, extracted on Internet from Proquest database on 8/11/2004 discloses configuring a computer system from home via Internet.

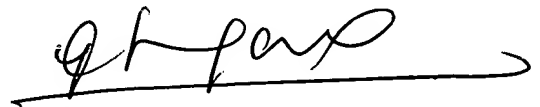
(v) EP 0 803 808 A2 to Sanders discloses a browser interface system for configuring and administering a network server from a remote location (see abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
August 11, 2004